

APPEAL BRIEF

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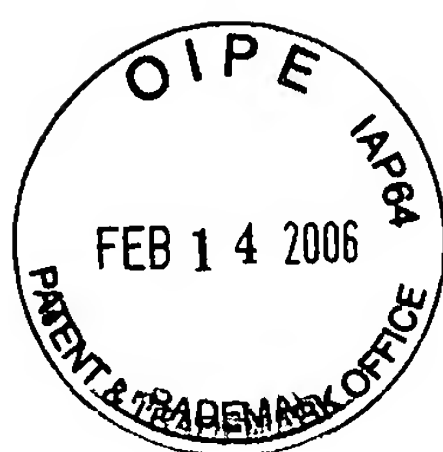


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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Minoru Tsuruta

Examiner: Charles H. Sam

Serial No.: 10/084,557

Art Unit: 3731

Filed: February 26, 2002

Docket: 15226

For: MEDICAL RETRIEVAL
INSTRUMENT

Dated: February 10, 2006

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APPEAL BRIEF

Sir:

I. INTRODUCTION

Pursuant to 35 U.S.C. § 134 and 37 C.F.R. § 41.37, entry of this Appeal Brief in support of the Notice of Appeal filed November 16, 2005 in the above-identified matter is respectfully requested. This paper is submitted as a brief setting forth the authorities and arguments upon which Appellants rely in support of the appeal from the Final Rejection of Claims 36-39 in the above-identified patent application on May 16, 2005.

II. STATEMENT OF REAL PARTY OF INTEREST

The real party of interest in the above-identified patent application is Olympus Corporation.

III. STATEMENT OF RELATED PROCEEDINGS

There are no pending appeals or interferences related to this application to Appellant's knowledge. See Appendix C.

IV. STATEMENT OF SUPPORTING DOCUMENTS

No affidavits, documents, or other evidence is being entered into the record in support of this Appeal. See Appendix B.

V. STATEMENT OF CLAIM STATUS AND APPEALED CLAIMS

A. Claim Status

Claims 1-21 stand canceled.

Claim 22 stands allowed.

Claims 23-30 stand canceled.

Claim 31 stands allowed.

Claims 32-35 stand canceled.

Claim 36 stands rejected based on 35 U.S.C. § 102(b) as being anticipated by 5,064,428 to Cope et al.

Claim 37 stands rejected based on 35 U.S.C. § 102(b) as being anticipated by 5,064,428 to Cope et al., and based on 35 U.S.C. § 103(a) as being unpatentable over 5,064,428 to Cope et al., in view of U.S. Patent No. 6,264,664 to Avellanet.

Claim 38 stands rejected based on 35 U.S.C. § 102(b) as being anticipated by 5,064,428 to Cope et al.

Claim 39 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over 5,064,428 to Cope et al., in view of U.S. Patent No. 6,264,664 to Avellanet.

B. Appealed Claims

Claims 36-39 are appealed, a clean copy of which are attached hereto in Appendix A along with the canceled and allowed claims.

VI. STATEMENT OF AMENDMENT STATUS

The claims were not amended in the Response to the Final Rejection filed July 14, 2005.

VII. STATEMENT/EXPLANATION OF INVENTION

The present application, U.S. patent application Serial No. 10/084,557 was filed on February 26, 2002, originally included Claims 1-26.

In an Official Action dated October 21, 2003, the Examiner indicated that claim 22 contains allowable subject matter and would be allowed if rewritten in independent form including any limitations of its base claim and any intervening claims. The Examiner further rejected claims 1-21 and 23-26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,906,622 to Lippitt et al.

In a Response under 37 C.F.R. § 1.111, filed December

16, 2003, the Applicant canceled rejected claims 1-21 and 23-26 and rewrote dependent claim 22 in independent form to incorporate the features of claim 1 and intervening claim 16. Furthermore, the Applicant added new claims 27-35.

In a first Final Official Action, issued March 12, 2004, the Examiner indicated that claim 31 contained allowable subject matter. Furthermore, the Examiner rejected claims 27-29, 32, 33, 34, and 35 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. 1989-172813 to Kenichiro et al. and rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Kenichiro in view of U.S. Patent No. 6,264,664 to Avellanet.

In a Response under 37 C.F.R. § 1.116, filed May 17, 2004, the Applicant rewrote dependent claim 31 in independent form including all of the limitations of its base claim (27). Furthermore, the Applicant amended claims 27 and 33-35 to clarify their distinguishing features.

Subsequent to a first Advisory Action issued on August 11, 2004, the Applicant filed a Request for Continued Examination (RCE) on August 24, 2004.

Subsequent to the RCE, another Official Action issued on November 17, 2004 in which the Examiner rejected claims 27-29, and 32-35 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. 1989-172813 to Kenichiro et al. and rejected claim 30 under 35 U.S.C. § 103(a) as being

unpatentable over Kenichiro in view of U.S. Patent No. 6,264,664 to Avellanet.

In a Response under 37 C.F.R. § 1.111, filed February 16, 2005, the Applicant canceled rejected claims 27-30 and 32-35 and added new claims 36-39.

In a second Final Official Action, issued May 16, 2005, the Examiner withdrew the previous grounds of rejection in favor of new rejections. Specifically, the Examiner rejected claims 36-38 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,064,428 to Cope et al. and rejected claims 37 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Cope in view of U.S. Patent No. 6,264,664 to Avellanet.

In a second Response under 37 C.F.R. § 1.116, filed July 14, 2005, the Applicant respectfully traversed the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a).

Subsequent to a second Advisory Action issued on October 19, 2005, an Appeal Brief was filed on November 16, 2005. The second Advisory Action does not explain the Examiner's reasoning for maintaining the rejection of claims 36-39 other than arguing that "claims 36-39 still read on Cope et al. (5,064,428) and claim 39 is still rejected based on the Applicant's arguments."

Consequently, Claims 36-39 are the claims on appeal. A copy of the rejected claims is attached hereto in the Appendix along with the canceled and allowed claims.

The invention with respect to claim 36 comprises a medical retrieval instrument (e.g., reference numeral 1A-Figure 1) comprising: a sheath (e.g., reference numeral 4-Figure 1A and page 5, lines 20-27); at least one filament provided in a distal end portion of the sheath (e.g., reference numeral 7-Figure 1A and page 6, line 3 to page 7, line 3) for holding an object (e.g., page 12, lines 1-5); a fixing member provided in the distal end portion of the sheath for fixing one end of the at least one filament to the instrument (e.g., reference numeral 21-Figure 1B and page 7, lines 12-17); wherein at least one of the sheath and the fixing member has a groove on its surface (e.g., reference numeral 22-Figures 1C, 1D and 2 and page 7, line 18 to page 8, line 2), the groove is provided in a predetermined position and direction for accommodating and fixing the one end of the at least one filament in the predetermined position and direction regulated by the groove (e.g., page 7, line 18 to page 8, line 15).

The invention with respect to claim 37 comprises the medical retrieval instrument of Claim 36, wherein an adhesive is applied in the groove for fixing the at least one filament to the instrument (e.g., reference numeral 23-Figure 1C and page 8, lines 5-7).

The invention with respect to claim 38 comprises a medical retrieval instrument (e.g., reference numeral 1A-Figure 1) comprising: a sheath (e.g., reference numeral 4-Figure 1A and page 5, lines 20-27); at least one filament provided in a distal end portion of the sheath (e.g., reference numeral 7-Figure 1A and page 6, line 3 to page 7, line 3) for holding an object (e.g., page 12, lines 1-5); a fixing member provided in the distal end portion of the sheath for fixing one end of the at least one filament to the instrument (e.g., reference numeral 21-Figure 1B and page 7, lines 12-17); wherein at least one of the sheath and the fixing member has a hole (e.g., reference numeral 51-Figure 9 and page 15, line 24 to page 16, line 4), the hole is provided in a predetermined position and direction for accommodating and fixing the one end of the at least one filament in the predetermined position and direction regulated by the hole (e.g., page 16, lines 4-16).

The invention with respect to claim 39 comprises the medical retrieval instrument of Claim 38, wherein an adhesive is applied in the hole for fixing the at least one filament to the instrument (e.g., page 8, lines 5-7; page 15, lines 23 and 24 and page 26, lines 2-5).

VIII. STATEMENT/LIST OF EACH GROUND FOR REVIEW

- 1. The Rejection of claims 36-38, on appeal, under 35 U.S.C. § 102(b), as being anticipated by Cope et al. is improper.**

A. CLAIMS 36 and 38

The present invention as recited in claims 36 and 38 relate to a medical retrieval instrument having at least one filament in a distal end portion for holding an object. The filament is fixed at one end to the distal end of a sheath of the instrument with a fixing member.

In assembly processes of the prior art for medical retrieval instruments, precise mounting of the filament at a distal end portion of the instrument was difficult because the filament often slips on the distal end surface. Such a disadvantage of the prior art is discussed throughout the specification of the present application and in particular at page 2, lines 5-10 of the present specification which states:

Regardless of the above-mentioned problem, a medical retrieval instrument of the Japanese Utility Model Laid-Open Publication No. 1-172813 has a filament basket, one end of which is only held by a ring-like holding tube and fixed to a sheath. Such a mounting configuration is unstable, since one end portion of the filament basket easily slips on the outer surface. Therefore, it takes more time to mount one end portion of the filament basket at a predetermined position and in a predetermined direction (Emphasis Added).

Regarding this problem, the present invention as recited in claims 36 and 38 proposes providing a hole or a groove on the sheath or fixing member in a predetermined position and direction for accommodating and fixing the one end of the filament in such predetermined position and direction as regulated by the hole or groove. As a result of such a configuration, fixing the filament to the instrument in the assembly process becomes easy and the efficiency thereof is increased, as compared to the medical retrieval instruments of the prior art.

Claim 36 recites that a groove is provided in a predetermined position and direction for accommodating and fixing the one end of the at least one filament in the predetermined position and direction regulated by the groove. Claim 38 recites that a hole as the accommodation part is provided in a predetermined position and direction for accommodating and fixing the one end of the at least one filament in the predetermined position and direction regulated by the hole.

In stark contrast, Cope discloses a medical retrieval basket having metal alloy wires (104-106). A stainless steel tube (115-120) is crimped on an end of each wire and each of the crimped tubes is then fixed to a flat surface (121-126) of a tube (114) by spot welds or solder (column 4, lines 4-8 and Fig. 2). Thus, each of the crimped tubes on the wires must be

positioned on a corresponding flat recess prior to fixing thereto. Since the recesses are flat, there is no guide on the surfaces thereof to orient the crimped tubes at a precise position and direction. Therefore, the medical retrieval instrument of Cope suffers from the same disadvantages as those of the prior art discussed above and in the present specification, namely, the crimped tubes may slip during spot welding or soldering and make the assembly difficult and also may cause the wires to be oriented in a different direction and position than that intended. Cope does not contemplate the problem overcome by the present invention as recited in claims 36 and 38 nor does the medical retrieval instrument disclosed in Cope provide a solution thereto. Thus, Cope merely discloses a structure in which the ends of the wires (107-112) are fixed on the flat surfaces (121-126) with the tubes (115-120).

Turning now to the language of the claims, Cope does not disclose or suggest a groove or a hole as are recited in claims 36 and 38. The crimped tube of Cope may form a hole around a wire, but since such a hole is made in conformity with each filament, the hole has no "predetermined position and direction," its position and direction can only be the same as the position and direction of the wire attached thereto. There is simply no disclosure or suggestion in Cope of a groove or hole **provided in a predetermined position and direction** for

accommodating and fixing one end of a filament in the
**predetermined position and direction regulated by the groove or
hole.**

Thus, in the present invention as recited in the claims, a filament is accommodated in a groove or hole provided on the sheath or the fixing member. The groove or hole fixes the filament in the predetermined position and direction regulated thereby. Therefore, using the groove or hole as a guide, an assembly worker can easily fix the filament in a short time. On the other hand, in Cope a wire is fixed on a flat surface by means of a tube. The tube is crimped to tightly clamp the wire in its inner lumen. However, the bottom of the tube and the surface on which the tube is fixed are both flat (see Figure 2 of Cope), and there is no groove or hole with a predetermined position and direction that can be used as a guide for fixing the wire in the predetermined position and direction. Thus, in the assembly process, the sleeve may easily slip on the mating flat surface, and the advantages gained with the medical retrieval instrument recited in the claims are not possible.

With regard to the rejection of claims 36-38 under 35 U.S.C. § 102(b), a medical retrieval instrument having the features discussed above and as recited in independent claims 36 and 38, is nowhere disclosed in Cope. Since it has been

decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 36 and 38 are not anticipated by Cope. Accordingly, independent claims 36 and 38 patentably distinguish over Cope and are allowable.

Withdrawal of the rejection to the independent claims 36 and 38 is therefore respectfully requested.

B. CLAIM 37

Claim 37 being dependent upon claim 36 is thus at least allowable therewith.

2. The Rejection of claims 37 and 39, on appeal, under 35 U.S.C. § 103, as being unpatentable over Cope et al. in view of Avellanet is improper.

Claim 37 being dependent upon claim 36 is thus at least allowable therewith.

Claim 39 being dependent upon claim 38 is thus at least allowable therewith.

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

IX. CONCLUSION

Based on the above arguments and remarks, Appellants respectfully submit that the claims of the instant invention on appeal are not anticipated or obvious in light of Cope et al. and Avellanet, either individually or in combination. Consequently, the rejections of the claims based on such references are in error. In view of the remarks submitted hereinabove, the references applied against Claims 36-39 on appeal do not render those claims unpatentable under 35 U.S.C. §§ 102 and 103. Thus, Appellants submit that the §§ 102 and 103 rejections are in error and must be reversed.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection herewith to Deposit Account No. 19-1013/SSMP.

Respectfully submitted,



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APPENDIX A

CLAIMS ON APPEAL: CLAIMS 36-39

Application Serial No. 10/084,557

1-21. (Cancelled)

22. (Allowed) A medical retrieval instrument comprising:

a plurality of filaments for holding an object;

a hollow section, through which a first end of each of the plurality of filaments passes, the hollow section including a fixing section for fixing a second end of each of the plurality of filaments;

wherein the hollow section comprises a first member through which one end of each of the plurality filaments passes, the hollow section comprises a second member engaged with the first member, the fixing section includes a plurality of grooves formed on an engagement surface at which the first member and the second member engage, and an elongated direction of the plurality of grooves is slanted with respect to an extending direction of the first member or an elongated direction of the second member.

23-30. (Cancelled)

31. (Allowed) A medical retrieval instrument

comprising:

at least one filament provided in a distal end portion of the instrument for holding an object; and

a fixing member provided in the distal end portion of the instrument for at least fixing one end of the at least one filament to the instrument, the fixing member having an accommodation part for accommodating and fixing the one end of the at least one filament in a predetermined position and direction,

wherein the accommodation part is slanted in respect to the longitudinal direction of the instrument.

32-35. (Cancelled)

36. (Rejected) A medical retrieval instrument comprising:

a sheath;

at least one filament provided in a distal end portion of the sheath for holding an object;

a fixing member provided in the distal end portion of the sheath for fixing one end of the at least one filament to the instrument;

wherein at least one of the sheath and the fixing member has a groove on its surface, the groove is provided in a predetermined position and direction for accommodating and fixing the one end of the at least one filament in the

predetermined position and direction regulated by the groove.

37. (Rejected) The medical retrieval instrument according to claim 36, wherein an adhesive is applied in the groove for fixing the at least one filament to the instrument.

38. (Rejected) A medical retrieval instrument comprising:

a sheath;

at least one filament provided in a distal end portion of the sheath for holding an object;

a fixing member provided in the distal end portion of the sheath for fixing one end of the at least one filament to the instrument;

wherein at least one of the sheath and the fixing member has a hole, the hole is provided in a predetermined position and direction for accommodating and fixing the one end of the at least one filament in the predetermined position and direction regulated by the hole.

39. (Rejected) The medical retrieval instrument according to claim 38, wherein an adhesive is applied in the hole for fixing the at least one filament to the instrument.

APPENDIX B

EVIDENCE SUBMITTED

Application Serial No. 10/084,557

There is no evidence submitted by the Appellant in this appeal.

APPENDIX C

RELATED PROCEEDINGS

Application Serial No. 10/084,557

There are no pending appeals or interferences related to this application to Appellants' knowledge.